



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,974	07/31/2000	Katsuo Doi	1035-276	4498

7590 09/30/2003
Nixon & Vanderhye PC
1100 North Glebe Rd
8th Floor
Arlington, VA 22201-4714

EXAMINER

NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 09/30/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,974

Applicant(s)

DOI ET AL.

Examiner

Phuoc H. Nguyen

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to system and method for storing and counting the reference information for each referring URL, classified in **class 709, subclass 217**.
 - II. Claims 14-24, drawn to system and method for displaying proposed access points when browsing file objects having a hyperlink structure, classified in **class 707, subclass 10**.
2. Inventions I, and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as system and method for storing and counting the reference information for each referring URL, classified in a *different Class/Subclass*. Invention II has separate utility such as system and method for displaying proposed access points when browsing file objects having a hyperlink structure, classified in a *different Class/Subclass*. See MPEP 806.05(d).
3. The inventions are distinct, each from the other, because of the following reasons:
 - (a) These inventions have acquired a separate status in the art as shown by their different classifications.
 - (b) The search required for each Group is different and not co-extensive for examination purposes.

For example, the searches for the two inventions would not be co-extensive because these Groups would require different searches on PTO's classification class and subclass as following:

The Group I search (claims 1-13) would require use of search **class 709, subclass 217** (not require for the inventions II).

The Group II search (claims 14-24) would require use of search **class 707, subclass 10** (not require for the inventions I).

For the reasons given above restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Warren Burnam on September 9, 2003 a provisional election was made without traverse to prosecute the invention of GROUP I, claims 1-13. Affirmation of this election must be made by applicant in responding to this Office Action. Claims 14-24 withdrawn from further consideration by the Examiner, 37 C.F.R. 1.142(b), as being drawn to a non-elected invention.

5. Application is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (h).

Claim Objections

7. Claim 1 objected to because of the following informalities: Referring to page 72, 1st claim, the applicants fail to enter the claim number. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-13 rejected under 35 U.S.C. 102(e) as being anticipated by Wilsher et al. U.S. Patent 6,160,552.

10. Referring to claims 1, 12, and 13, Wilsher reference disclose reference information storing means for storing a referring URL (Uniform Resource Locator) that referred to a data file accessed by the client computer as reference information (figure 7; col. 5, lines 46-51, and col. 11, 2nd paragraph); and counting means for counting the reference information to obtain a total number of times references made for each referring URL (col. 6, lines 28-42).

11. Referring to claim 2, Wilsher reference disclose information source monitor device is incorporated into the client computer (col. 1, lines 23-42; and col. 5, 1st paragraph).

12. Referring to claim 3, Wilsher reference disclose information source monitor device is constructed as a part of a browser in the client computer (Figures 1-6; col. 1, lines 23-42; and col. 5, 1st paragraph)

13. Referring to claim 4, Wilsher reference disclose information source monitor device is positioned at a relay point between the server computers and the client computer (Figures 2-5).

14. Referring to claim 5, Wilsher reference disclose reference information extracting means for extracting information of a referring URL from a request header which is issued by the client:

Art Unit: 2143

computer when the client computer accesses a data file on the server computer (col. 5, lines 14-26).

15. Referring to claim 6, Wilsher reference disclose reference information extracting means extracts a data type of a data file from a response header which is issued by the server computer when the client computer accessed the data file on the server computer (col. 5, lines 14-26).

16. Referring to claim 7, Wilsher reference disclose sorting means for counting the reference information according to data types to find a total number of times reference was made to each referring URL (Abstract; col. 10, 2nd and 3rd paragraph).

17. Referring to claim 8, Wilsher reference disclose data converting means for converting data of the reference information into a displayable data format (col. 6, lines 7-54).

18. Referring to claim 9, Wilsher reference disclose reference information storing means further storing a text belonging to a data file accessed by the client computer (col. 6, lines 7-54).

19. Referring to claim 10, Wilsher reference disclose information accumulating means for accumulating as a cache a predetermined amount of data files accessed by the client computer; and, information updating means for updating data files at referring URLs and data files linked to the data files at the referring URLs at a predetermined link level in the cache at predetermined time intervals according to a counting result of the reference information by accessing a corresponding server computer (col. 5, lines 46-51; col. 6, lines 28-42; col. 10, 2nd paragraph; and col. 11, 2nd paragraph).

20. Referring to claim 11, Wilsher reference disclose searching means for searching the data files in the cache (col. 4, lines 22-53).

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakai et al. U.S. Patent 6,170,016

Inohara et al. U.S. Patent 6,182,111

Farber et al. U.S. Patent 6,185,598

Kobayakawa et al. U.S. Patent 6,119,078

Hoyer et al. U.S. Patent 6,381,635

Hoyer et al. U.S. Patent 6,263,361

Weinberg et al. U.S. Patent 6,144,962

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 703-305-5315. The examiner can normally be reached on Mon -Thu (7AM-4:30PM) and off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Phuoc H. Nguyen
Examiner
Art Unit 2143

September 17, 2003

Application/Control Number: 09/629,974
Art Unit: 2143

Page 7

A handwritten signature in black ink, appearing to be 'DW' or similar, written in a cursive style.

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100